

"requires the disclosure in a single reference of every element of the claimed invention." Ex parte Levy ____ F.2d ____, 17USPQ2d 1461, 1462 (Bd. Pat. APP, 1990)

In addition:

"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Levy, supra.

As explained below, Contois does not disclose every element of the invention of claims 30-45.

In order for Contois to anticipate, it must clearly disclose the following limitations present in claims 30-39:

"circuitry, coupled to the source and the output device, including executable instructions for building a displayable inventory of works and for creating and displaying an executable play list of works on the output device, including at least some of the works in the inventory, at the same time that a portion of the inventory is being displayed; and additional instructions for creating an editing command overlay for editing the displayed list of works." (claims 30-39).

In addressing the above limitation of claims 30-39, the Examiner in the Office Action referred to "additional instructions for creating an editing command ... editing the displayed ... " (see Col. 5, ll. 6-25). That section of Contois provides no discussion whatsoever of editing features or editing structure. It is submitted that the above-quoted portion of the Examiner's rejection of claims 30-39 as anticipated does not identify where Contois discloses the above-quoted limitation from claims 30-39.

In Contois, to the extent that a play list can be edited, the process is carried out on two different screens. Figures 2-4 illustrate one type of screen which permits a user to add songs to a list. The list is clearly illustrated in the lower left section of the screen in each case. Fig. 5

illustrates a different screen, one which only lists "selected songs" but which provides a delete function and a clear function.

Contois, col. 11, lines 30-67, describes an editing structure, which is consistent with Figs. 2-4 and 5 of Contois but which is quite different from the claimed structure. As noted in col. 11:

"In operation, once a piece of music is selected, a user may activate the button labeled 'Add to Song List' (see Figs. 2-4) which is located at the bottom center of each screen. By using this button, a user can create their own personal record album or compact disk which contains only those songs that have been individually selected. Thereby, the player piano can be directed to play each song one after the other in sequence or in a random order.

Once a list of songs has been selected, using the 'Add to Song List' button the user can view, customize, and edit the created list. A user selects 'File' from the menu bar as illustrated in Fig. 4, and selects 'Song List' or by actuating the control and S key simultaneously." (Col. 11, lines 32-43).

The above processes are reflected in Figs. 2-4 is limited to permitting a user to add songs to a list. No other processing in the nature of editing is permitted. Nor do any of these screens disclose the presence of "additional instructions for creating an editing command overlay for editing the displayed list of works" as claimed. Additionally, with respect to Fig. 5, Contois states:

"Fig. 5 illustrates a basic Song List screen with the associated operational buttons. Note, that the songs listed under the Selected Songs heading (Moonlight Sonata, As Time Goes By, and the Entertainer) were recently added to the song list. The user has several options to use on these newly listed songs. First, by activating the "Save Long List" button, the user can save the song list and give the list a name that could be used latter [sic] to both identify and access this newly created

list. Second, by activating the Play Song List button, the user could also play the displayed list of songs on the player piano without ever having saved the created song list. Third, the user could edit the song list by using the 'Delete Song' button thereby eliminating any song that was highlighted or selected." (Col. 11, lines 45-58).

As was the case with the screens of Figs. 2-4, the screen of Fig. 5 is completely devoid of any overlay as claimed. Contois teaches an editing process which incorporates one screen for adding songs to a play list and a different screen for deleting songs from a play list. Contois thus uses alternate or different screens to carry out an editing process which is quite different and unlike the claimed apparatus. Hence, Contois cannot anticipate pending claims 30-39. Withdrawal of that rejection is respectfully requested.

In rejecting claim 33 as anticipated, the Examiner stated:

"Contois teaches 'edit one of an audio output device ... " (Col. 4, ll 38-62). (P. 3, Office Action, ll. 1 and 2).

Claim 33 adds the following limitation:

"circuitry for presenting the works on a selected, edited list to one of an audio output device or a video output device." (claim 33).

The " selected, edited list" referred to in claim 33 is one of the edited lists of works which has been edited by the "editing command overlay" of claim 30. No such structure is disclosed in Contois. In support of the rejection of claim 33, the Examiner referred to Col. 4, ll. 38-62 of Contois which we quote as follows:

"The interface is for providing a user access to media pieces stored in a media database. The interface is also for controlling a media playing device, like a

player piano or movie playing video device, that is coupled to the computer to play the accesses or selected piece of media.

It is another feature of the invention to provide a computer interface that allows a user to display only music that relates to a selected category, like jazz or classical. Whether user is then able to direct the media playing device to automatically play the selected music pieces related to the selected music categories.

A further feature of the invention is or provide a computer interface that allows a user to display music selections that are related only to a selected composer, like Duke Ellington or Gershwin. Where the user is then able to direct the media playing device to automatically play the selected music pieces related to the selected music composer.

Another feature of the invention is to provide a computer interface that allows a user to display only music that is related to a selected artist, like Dave Contois, or your own personal recordings. Where the user is then able to direct the media playing device to automatically play the selected music pieces related to the selected music artist."

Given the general statements in the above-noted quote, the structure of claim 33 taken as a whole is not disclosed therein. Merely pointing to Col. 4, ll. 38-62 in support of an anticipation rejection as in this case is not sufficient to meet the requirement that anticipation:

"requires the disclosure in a single reference of every element of the claimed invention ... Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Levy, supra.

The rejection of claim 33 does not meet the above standard. The rejection has not addressed the detailed limitations of claim 33.

For the same reasons stated above relative to claim 33, claim 34 is also not anticipated.

In rejecting claims 35 and 38, the Examiner stated that Contois teaches:

"analysis of the characteristics of works on a selected list" (see Col. 9, ll. 42-62)."

The limitation of claim 35 requires:

"instructions for conducting analysis of the characteristics of works on a selected list."

The section of Contois referred to by the Examiner states in part:

"the interface has a button, labeled 'All Categories, Composers, Artists, and Songs,' also known as a 'select all' button. This button can be activated any time by the user to enable the user to display all the individual items in each data field that is found in the entire database. This feature of 'select all' is activated when first starting the user interface screen, thus allowing a user to view all of the available data in each data field before making any item selections." (Col. 9, ll. 42-51)

None of the above paragraph discloses to the claimed "instructions for conducting analysis of the characteristics of works on a selected list."

The reminder of the text, namely, Col., 9, ll. 52-66, as quoted below, is not directed to works on a selected list. Rather, it refers to categories into which groups of works can be accumulated. From various categories, a user can create one or more lists. The following process relied on by the Examiner, however, does not correspond to the quoted limitation,

namely "instructions for conducting analysis of the characteristics of works on a selected list." Contois does not analyze the contents of "a selected list". As stated by Contois"

"Displayed on the user interface screens of FIGS. 2, 3, 4, and 6 are four categories of data that may be accessed from the player piano data base. Specifically, the data base categories are labeled as: Category (a short form of music category), Composer, Artist, and Selected Songs. Located below each data base category is a respective data field that list the items or data found in the data base that are associated with the particular category. A description of each data field will now be provided.

The data field labeled as "Category," as the title signifies, displays all of the general music category items found in the data base. For example, blues, Christmas, classical, gospel, jazz, pianosoft, and ragtime music category items are illustrated."

The above does not disclose the limitations of Claim 35. Additionally, the limitation of claim 38, namely:

"instructions establishing information pertaining to at least one of invoicing, royalty paying, demand analysis, or, popularity of selected works" (claim 38)

is not disclosed anywhere in Col. 9, ll. 42-66 as asserted by the Examiner. Contois does not address "establishing information" as claimed.

In rejecting claim 39 as anticipated, the Examiner has asserted:

"Contois teaches 'download a work on a selected play list ... ' (see fig. 1, whereas the serial MIDI (28) is used to download MIDI files)." (P. 3, Office Action, ll. 9, 10).

The above quoted assertion has failed to address all of the limitations of claim 39 which includes:

"instructions to download a work on a selected play list wherein the work is not available locally." (Claim 39; emphasis added).

The disk 28 of Contois as disclosed in Fig. 1 thereof is coupled by a wired connection to UART 36. This is a hardwired local connection. As stated by Contois:

"a recorded media 26 containing music to be reproduced is read by a playback unit 28. Coupled to playback unit 28 is control microprocessor 30 that selects the strike map for each driving signal 10 corresponding to a particular velocity factor of a hammer to hit a piano a piano string ... Also coupled to CPU 32 is UART 36, a serial data receiver that receives the serial MIDI data from playback unit 28 and routes it to CPU 32." (Col. 8, ll. 23-34).

As the above text makes clear, the playback unit 28 is local and directly connected to the processor 32 of Contois. Hence, what Contois is describing is reading information off a disk 26 using a local disk drive 28 which is connected with a hardwired connection to an input device UART 36. This does not correspond to the claimed limitation, namely:

"instructions to download a work on a selected play list wherein the work is not available locally."

Not only is the disk drive 26 local to the processor 32, the claimed instructions are not disclosed in Contois. The information on disk 26 is read and then output to gating logic 42 which in turn via transistor 46 can drive solenoid 48 in an associated player piano. (Col. 8, ll. 42-50). This process does not disclose the apparatus of claim 39. Contois simply does not

anticipate any of claims 30-39 for all of the above reasons and the rejections of those claims as anticipated should be withdrawn.

The Examiner has rejected claims 40 and 42 as anticipated based on the same rationale for rejecting claim 30. However, that rationale has not addressed the following specific limitation from claims 40 and 42 which is not anticipated by Contois:

"circuitry, coupled to the source and the output device, for building an inventory list of works and for creating a display of a list of works of at least some of the inventory on the output device wherein the circuitry includes instructions for selecting works in accordance with a selected characteristic and for executing a plurality of such selected works."

Relative to the above-quoted limitation, nothing set forth in the rejection of claim 30 by the Examiner, page 2 of the Office Action, addresses that limitation. Particularly the portion of the limitation which states:

"wherein the circuitry includes instructions for selecting works in accordance with a selected characteristic, and for executing a plurality of such selected works."

Unlike the above-quoted limitation, Contois merely discloses an inventory list, see upper half of the screen of each of Figs. 2-4, which specifies groups of works. A user must then select among the various groups of works to create a list of selected songs, illustrated in the bottom half of each of Figs. 2-4. This is accomplished by the user clicking on the "add to song list" button present on the screen of each of Figs. 2-4. Contois requires manual involvement of the user in selecting each song for a list. As described by Contois:

"For example, regarding Fig. 3, by selecting Beethoven as shown, all of the other data fields may be directed to only displayed data found in the data base that pertains to the composer Beethoven. The user may now display only items in the

Artists and Selected Songs categories that are related to Beethoven. By providing a user with these features, hundreds or thousands of items are eliminated from being displayed on the user display thereby allowing the user to more easily make selections of music to be played upon the player piano." (Col. 10, ll. 27-36; emphasis added).

As the above-noted quote makes clear, it is the user who is directing the selection in Contois. It is not being carried out by "instructions for selecting works in accordance with a selected characteristic, and, for executing a plurality of such selected works" (claims 40-45).

The rejection of claim 41 as anticipated for the same reason that claim 33 was rejected is defective and improper. Claim 41 adds to claim 40 the following limitation:

"executable instructions for selecting works in accordance with one of a selected audio characteristic; a selected video characteristic, or, a selected popularity indicium."

The rejection of claim 33 refers to Col. 4, ll. 38-62 of Contois. That text, quoted above during the discussion of claim 33, does not disclose the above-noted limitation of claim 41. Claims 42, 43 and 44, which depend directly or indirectly from claim 41, are also improperly rejected for the same reasons. Claim 44 includes the following limitation:

"instructions for downloading a work not locally available." (claim 44, emphasis added).

and has been improperly rejected as anticipated by Contois. The Examiner has merely referred disk drive 28 which is a locally connected device which is connected by cable to UART 36. This does not correspond to "instructions for downloading a work not locally available." All of the works presented to Contois' system are locally available. In addition, the downloaded work is

one of the "plurality of such selected works" being executed. Contois discloses no such structure.

The rejection of claim 45 for the same reasons as claim 39 was rejected is also clearly defective in that claim 45 requires:

"instructions for presenting downloaded advertisements."

Nothing in the rejection of claim 39 addressed the above quoted limitation of claim 45.

For all of the above reasons, claims 40-45 have been improperly rejected as anticipated by Contois. Contois does not disclose all of the limitations of each of the rejected claims as required for anticipation. Those rejections should be withdrawn.

**The Rejections Of Claim 46-66 Under 35 USC 103(a)
As Obvious and Unpatentable Over Contois In View of Bernard et al**

Properly establishing a prima facie case of obviousness where teachings of two prior art documents are to be combined first requires that the documents or the prior art must be analogous prior art. The prior art in question must either be in the field of the applicants' endeavor or if not then reasonable pertinent to the particular problem with which the inventor is concerned. (MPEP 2141.01(a); In re Oetiker, 977 F.2d, 1443, 1447 (Fed. Cir., 1992).

Where the prior art documents meet the analogousness requirement, there must be some suggestion or motivation, either in the documents themselves or in the knowledge generally available to one of ordinary skill in the art to combine the documents such that when combined, the result teaches or suggests all of the claimed limitations. MPEP § 2141.03, p. 2100-121 (additionally, a proper prima facie case of obviousness cannot be made out in the absence of a motivation or suggestion to combine the prior art documents so as to meet every limitation of the claimed invention obvious.

The mere fact that prior art documents can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of that

combination. In re Mills, 916 F.2d 680, 16USPQ1430 (Fed. Cir. 1990), p. 2100-124 MPEP. Finally, all of the words in a claim must be considered in judging the patentability of the claim relative to the prior art MPEP p. 2100-126.

The Examiner has rejected claims 46-119 as obvious and unpatentable over Contois read in view of Bernard et al. For the following reasons, it is submitted that no proper suggestion or motivation to combine Contois with Bernard et al as proposed by the Examiner has been articulated. Additionally, any such combination fails to disclose or make obvious all of the limitations of the respective claims as the combination has been articulated by the Examiner in the Office Action.

In order to combine Contois and Bernard et al, they must be analogous art. This means, they must either be:

"in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." Oetiker, supra.

The system of Contois is quite different from and has a completely different purpose than does the system of Bernard et al. Bernard et al is non-analogous prior art.

Contois deals with a particular form of a system enabling a user to create executable play lists for presentation on a local output device such as a player piano. Contois discloses obtaining works from a local disk drive 28 connected to processor 30. Works can be presented by an output device such as a player piano without change. Contois collects no information as to presented works..

Bernard et al, unlike Contois, is a product purchasing system. The preferred embodiment in Bernard et al is a telephone based call-in system where a user interacts audibly, and with a telephone key pad, to voice response units for purposes of placing orders for media such as CD's or the like, see Fig. 1, Bernard et al. As with any form of an automated purchasing system, provision is made to enable a user to pay for the acquired products and to have them delivered by shipping, see Figs. 29, 30, or directly delivered to the purchaser, see Fig. 44.

The two systems, Contois and Bernard et al, represent non-analogous prior art. What is required by Oetiker, supra is:

"common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor".

The Examiner has not shown why a person seeking to solve a problem of presenting lists of audible or visible works in real-time to a user would "reasonably be expected or motivated to look to "automated product sales systems Oetiker, supra. Common sense dictates that a person looking to solve a problem in building user executable play lists would not reasonably be expected to look to product purchasing systems.

Nothing about either of Contois or Bernard et al suggests combining one with the other except for the teachings of the present application. Use of the present application to create a rationale for combining Contois and Bernard et al to support an obviousness rejection is clearly a form of hindsight reconstruction which is improper.

The Examiner stated "Bernard et al teaches "royalty payment, or, billing information" (see col. 7, lines 38-55)." However, col. 7, lines 38-55 deal with a brief description of Figs. 13-16, of the Bernard et al patent. Neither the brief description nor the figures address royalty payment or billing information.

In addition, the Examiner's rationale of:

"using the steps of 'royalty payment, or billing information' would have given those skilled in the art the tools to track and gauge the purchasing of musical items"

does not find support in Contois which teaches the presentation of works at no charge. Contois does not sell products. Bernard et al in selling products has no concern with royalty payments. It is only the present application that addresses collection of royalty payment information, popularity information or the like in the context of play list systems.

Thus, for the above reasons, Bernard et al is non-analogous art and cannot be properly combined with Contois.

In summary, given the fact that Contois is completely silent pertaining to royalty payment or billing information, as acknowledged by the Examiner in Section 5 of the Office Action, the Examiner's assertion to combine the teachings of Bernard with the teachings of Contois "because using the steps of 'royalty payment, or, billing information' would have given those skilled in the art the tools to track and gauge the purchasing of musical items does not articulate a proper suggestion or motivation to combine the teachings of Contois with Bernard et al. The Examiner has attempted to justify the combination in that it "would have given those skilled in the art the tools to track and gauge the purchasing of musical items." However, this is merely a speculative conclusion with no justification, other than the teachings of the present application, given the fact that Contois is only a listening or a viewing system and Bernard et al is oriented toward selling products.

The rejections of claims 46-119 as obvious and unpatentable over Contois in view of Bernard et al are improper and should be withdrawn. It is also important to keep in mind that it is the claims as a whole that must be obvious. The mere fact that a particular limitation of a claim may be obvious does not make the claim itself obvious. In articulating the obviousness rejections, the Examiner has failed in many instances to focus on the respective claim as a whole. Rather, only specific limitations have been addressed.

In this regard, notwithstanding the deficiencies discussed in the teaching of Contois, the Examiner has rejected claims 46 and 47 as obvious. Relative to claim 46 which requires:

"instructions for establishing at least one of royalty payments, or, billing information."

The Examiner has failed to articulate why claim 46 taken as a whole would have been obvious. The Examiner has admitted that Contois does not address royalty payment or billing information. Rather, it is a for-free presentation system.

As explained above, Contois cannot be properly combined with Bernard et al. Even when so-combined, claim 46 is not made obvious.

Claim 46 includes limitations from claim 43, 42, 41 and 40. Those limitations in combination were not anticipated by Contois, as discussed above. Claim 46 defines a system which:

"includes instructions for selecting works in accordance with a selected characteristic, and, for executing a plurality of such selected works ... which includes instructions for establishing at least one of royalty payments, or, billing information." (claim 46)

Bernard et al does not teach "instructions for selecting works in accordance with a selected characteristic" (claim 46). The Examiner has failed to articulate a proper suggestion or motivation to combine Contois with Bernard et al. He has failed to identify where in Bernard et al, the teaching is of "royalty payment, or, billing information" and has failed to identify the required suggestion or motivation to combine Contois and Bernard et al so as to make claim 46 obvious. As noted above, the Examiner's speculative comment that such a combination "would have given those skilled in the art the tools to track and gauge the purchasing of musical items" can only have been motivated by the teachings of the present application as there is nothing whatsoever in Contois or Bernard et al which properly provides the required suggestion or motivation. This is especially the case given the non-analogous nature of Bernard et al.

Claim 47 which depends from claim 46 was also summarily rejected improperly by the Examiner. The rejection of claim 47 simply does not address the limitation added by claim 47, namely:

"instructions for downloading a work not locally available."

In the rejection of claim 47, reference is made to rejected claim 34 which has nothing whatsoever to do with the above-noted limitation from claim 47. The rejection of claim 47 does not conform to the statutory standard.

The rejections of claims 48, 49 and 58 are based on rejections of claim 30 and 46 without providing any specific justification for the rejections of those claims. For example, claim 48 includes the following limitation not made obvious by Contois or Bernard et al alone or in combination:

"executable instructions for executing the play list and for maintaining information pertaining to royalty payments."

Claim 49 adds to claim 48 the following limitation:

"additional instructions for maintaining information as to popularity of various works."

Relative to claim 48, as admitted by the Examiner, Contois does not address or teach royalty payment or billing information. Bernard et al does not teach royalty payments. As described above, the assertion to that effect on page 4 of the Office Action, line 15, is incorrect. A review of the text of Col. 7, ll. 38-55 of Bernard et al makes it clear that royalty payments are not addressed. Nor are royalty payments addressed in the figures referred to, Col. 7, ll. 38-55, of Bernard et al.

In rejecting claims 48 and 49, no specific suggestion, motivation, or teaching in either Contois or Bernard et al has been identified by the Examiner as pertaining to royalty payments and further which would make obvious the above-quoted limitation from claim 48. Mere silence in Contois and in Bernard et al does not provide a basis for arguing that the combination of the teachings of the two patents makes obvious the limitation of "executable instructions for executing the play list and for maintaining information pertaining to royalty payments." There is nothing in the Office Action to establish that the previously quoted limitation from claim 48

would be obvious. The Examiner's general and broad conclusion of obviousness simply does not address the above-quoted unique limitation.

Similar comments apply to the limitation of claim 49. Contois is completely silent relative to "maintaining information as to popularity of various works". The same can be said of Bernard et al. Nothing in the Office Action has pointed out with any specificity as to why the alleged combination would make obvious:

"additional instructions for maintaining information as to the popularity of various works." (claim 49)

The rejection of claim 58 (rejected on the same basis as claims 48 and 49) is similarly defective in that it includes the following limitation which has not been addressed in the rejection:

"executable instructions for executing the play list and for maintaining popularity information pertaining to works from at least one executed play list."

Contois is completely silent in this regard as is Bernard et al. An obviousness rejection must address the wording in the limitations of the respective claim. A proper prima facie case of obviousness requires more than a mere conclusory statement that does not address the specific limitation, in this case added by claim 58.

The motivation for the combination proposed by the Examiner and the general conclusion of obviousness relative to claims 48, 49 and 58 is coming from the present application. This is a clear case of improper hindsight reconstruction which is to be guarded against. These rejections also fail to meet the statutory standard and should be withdrawn.

In rejecting claims 50-57 as obvious and unpatentable over Contois read in view of Bernard et al, the Examiner merely referred back to previously rejected claims without considering each of claims 50-57 as a whole. For example, each of the claims 50-57, dependent on claim 48, includes the above-noted non-obvious limitation from claim 48, namely:

"executable instructions for executing the play list and for maintaining information pertaining to royalty payments."

The deficiency relative to that limitation of Contois and Bernard et al alone or in combination was discussed above. Hence, these claims are allowable for at least the same reasons that claim 48 was allowable as discussed above, neither Contois nor Bernard et al addresses royalty payments. The Examiner has not, given this failure of either prior art document to address royalty payments, provided any suggestion, motivation, or teaching which would result in making each of the respective claims 50-57 as a whole obvious given the fact that the above-noted limitation is not obvious.

Specifically, claim 50 adds to the structure of claim 48 the following additional limitation:

"instructions for presenting advertisements" (claim 50)

In rejecting claim 50, the Examiner referred to the rejection of claim 45. Claim 45 was rejected for the same reasons that claim 39 was rejected. As discussed above, the rejection of claim 45 was defective since Contois does not discuss advertisements. Nor, as stated in the rejection of claim 39 does Contois teach "download a work on a selected play list ... ". The serial MIDI drive (28) of Contois can be used to read MIDI files on disk 26. However, there is nothing in Contois which teaches that those files are on a selected play list. Merely referring to the rejection of claim 45 does not provide the required specific rationale for rejecting claim 50 as obvious. Similar comments apply to the rejections of claims 51 and 52 which were rejected as obvious for the same reasons as claim 44 was rejected. Claim 44 was rejected for the same reasons as was claim 39. Once again, the Examiner has failed to provide a specific rationale as to why claims 51 and 52 would be obvious. Merely referring to the rationale for rejecting claim 39, that is "download a work on a selected play list ... " (see Fig. 1, whereas the serial MIDI (28) is used to download MIDI files)." is the sole rationale provided for rejecting claim 39.

Additionally, claim 57 includes the following limitation which is clearly not taught or suggested by either Contois or Bernard et al, either alone or in combination:

"wherein the executable instructions select works in accordance with pre-specified beats per time interval."

In Contois, the user selects works. This process does not make obvious the above quoted limitation from claim 57. In Bernard et al, the purchaser selects works. Both documents are completely silent as to the limitation added by claim 57. Hence, no proper prima facie showing has been made that claim 57 is obvious. The reference in the Office Action to the reasons for rejecting claim 36, namely that "Contois teaches 'sorting works in accordance with a pre-selected parameter' (see abstract)" does not address the specific and unique claimed selection criterion. Such very general and broad conclusions of obviousness are not in keeping with the requirements that a specific suggestion, motivation or teaching be articulated when combining prior art documents to make out a prima facie case of obviousness.

Similar comments apply to the rejections of claims 59-62 as obvious and unpatentable over Contois in view of Bernard et al. Each of those claims incorporates the following limitation of claim 58 which as discussed above, is simply not made obvious by the Examiner's combination:

"executable instructions for executing the play list and for maintaining popularity information pertaining to works from at least one executed play list."

Neither Contois nor Bernard et al refer to, teach or suggest the claimed instructions which pertain to "maintaining popularity information pertaining to works from at least one executed play list". Claims 59-62 are allowable for at least the same reasons as is claim 58. Additionally, claim 60 adds to claim 58 the following limitation not made obvious by Contois in view of Bernard et al:

"executable instructions for presenting advertisements." (claim 60)

The articulated rejection of claim 60 refers to the reasons for rejecting claim 50 which in turn refers to the reasons for rejecting 45 which in turn refers to the reasons for rejecting claim 39. Claim 39 was rejected because:

"Contois teaches 'downloading work on a selected play list ... (see Fig. 1, whereas the serial MIDI (28) is used to download MIDI files)." (P. 3, Office Action).

It is submitted that the articulated rejection of claim 39 has nothing whatsoever to do with the above-quoted limitation from claim 60. Nothing about the articulated rejection of claim 60 taken as a whole provides a suggestion or motivation as to why the limitation of claim 60, in combination with the structure of claim 58 would be obvious.

Similar comments apply to the rejection of claim 62 which refers to the rejection for claim 37 which merely refers to the Abstract of Contois. The general statement in the Abstract of Contois about selecting works does not discuss or address the unique limitations of claim 62, namely:

"wherein the criterion corresponds to beats per unit time and the executable instructions select works in accordance therewith."

Nothing in Contois suggests selecting works based on musical criteria as claimed.

In rejecting claim 63, the Examiner has merely referred to the reasons for rejecting claim 48. Claim 48 has been rejected as best understood for the reasons that claims 30 and 46 have been rejected. Yet neither Contois nor Bernard et al address the subject matter of the following limitation from claim 63 which was not made obvious by that combination:

"executable instructions for executing the play list and for displaying advertisements."

Contois is completely silent as to any reference to advertisements. Bernard et al which is directed to an automated purchasing system does not address "executing the play list and ... displaying advertisements" as claimed. Both Contois and Bernard et al are completely silent in this regard. Even the alleged suggestion by the Examiner on p. 4 to justify combining Contois and Bernard et al, namely:

"because using the steps of 'royalty payment, or billing information' would have given those skilled in the art the tools to track and gauge the purchasing of musical items."

fails to addresses or make obvious the above quoted limitation of claim 63. The Examiner has completely failed to establish a proper prima facie case as to why Contois combined with Bernard et al, given the proposed suggestion on p. 4 of the Office Action would make obvious the above-quoted limitation of claim 63. It is only the present application which teaches executing a play list and displaying advertisements. Claims 64 and 65 which depend from claim 63 are allowable for the same reasons as is claim 63. Additionally, claim 65 includes the following limitation not made obvious by Contois read in view of Bernard et al, namely:

"wherein the criterion corresponds to beats per unit time in the executable instructions select works in accordance therewith."

As noted above, a rejection, for example of claim 65, for the same reasons that claim 37 was rejected, namely, the Abstract of Contois, does not set forth a proper prima facie case of obviousness given the fact that this general conclusion of obviousness fails to address the specific criterion and obviousness thereof of claim 65. The cited documents, Contois and Bernard et al, alone or in combination, simply do not support and make obvious each of the limitations of claim 65 for the above reasons.

In rejecting claim 66 as obvious and unpatentable over Contois in view of Bernard et al, the Examiner merely referred to his rejection of claim 50. In rejecting claim 50, he merely referred to his rejection of claim 39. The rejection of claim 39 states that:

"Contois teaches 'download a work on a selected play list ... ' (see fig. 1, whereas the serial MIDI (28) is used to download MIDI files)." (P. 3, Office Action).

The above-stated rationale for rejecting claim 66 does not provide any specificity as to why the prior art documents alone or in combination would make obvious at least the following limitations of claim 66:

"executable instructions for creating at least one play list by selecting works in accordance with a predetermined criterion; and executable instructions for executing the play list and for maintaining information pertaining to at least one of billing information; royalty payments and popularity of works." (claim 66).

As noted above, an obviousness rejection based on a combination of prior art documents must articulate the specific suggestion or motivation to modify the documents so as to make the limitations of the pending claim obvious. The Examiner's rationale for rejecting claim 66 has nothing whatsoever to do with the above-quoted limitations and simply does not make them obvious without discussing the structure thereof. It fails to comply with the statutory standard.

In the Office Action, the Examiner rejected claims 67-116 as follows:

"These claims are rejected on grounds corresponding to the arguments given above for rejected claims 30-45 and 46-66 above and are similarly rejected."
(Office Action, p. 5, last 3 lines).

It is submitted that the above broad brush rejection of claims 67-116, given the limitations of those claims which are different from the limitations of claims 30-45 and 46-66 is

not in keeping with the statutory standard. As described above, Bernard et al do not represent analogous prior art to Contois. Thus, those two prior art documents cannot be properly combined to support a prima facie rejection of any of claims 67-116. Beyond that, however, the limitations of those claims are not made obvious even by the Examiner's combination. For example, in this regard, claim 67 includes the following limitations that are not made obvious by Contois in view of Bernard et al:

"first software executable at least in part at a user station for creating at least one list of multiple works; and second software executable at least in part at the user's station for downloading at least some of the works on the list, via a communication network available at least intermittently, from a remote source, to the user's station."

Contois does not address the claimed solution to missing works on an executable play list. Contois is completely silent in this regard. Bernard et al, as described above, is merely a product purchasing system and does not address creating play lists. Nor, does Bernard et al address missing works as claimed, namely:

"second software executable at least in part at the user's station for downloading at least some of the works on the list, via communication's network available at least intermittently, from a remote source, to the user's station."

Bernard et al teaches the purchasing of goods from a remote source and providing provisions for the delivery of such goods to the purchaser which is not analogous subject matter and adds nothing to the teaching of Contois in connection with executable play lists. The Examiner has not identified any specific suggestion, motivation, or teaching in either of Contois or Bernard et al alone or in combination which suggests not only making the combination proposed by the Examiner but modifying same so as to make the above-quoted limitations of claim 67 obvious. Those prior art documents simply do not address the problems solved by the

system of claim 67. Hence, for at least the above reasons, claim 67 is allowable over Contois in view of Bernard et al. Similar comments apply to the allowability of claims 68-91, all of which depend directly or indirectly from claim 67. For at least the above reasons, the rejections of those claims should also be reversed.

By way of further example, claim 72 adds to claim 67 the following unmet limitation:

"collection software to collect information used to keep track of the popularity of at least some of the works wherein the software is located, at least in part, at one of the user's station and the remote source."

Neither Contois nor Bernard et al alone or in combination address downloading works on a play list from a remote source and collecting information pertaining to popularity of the works as set forth in claim 73. Contois simply does not address popularity issues. Bernard et al's product purchasing system does not address collecting popularity information of works on play lists as claimed. Rather, it is oriented toward facilitating the purchase and delivery of product.

By way of further example, claim 77 adds to claim 67 the following limitation also not made obvious by Contois in view of Bernard et al:

"control software enabling a local user to select at least some works in a remote inventory based on selected characteristics of the works and view a screen containing at least some of the selected works, wherein the control software is located, at least in part, at one of the user's station or the remote source."

The Examiner has failed to identify any specific suggestion, teaching or motivation in either of the prior art documents relied on as to why the limitations of claim 77, including the above, would be obvious. As noted above, Fig. 1 discloses a locally based system in Contois which enables a user to select works to be output on a local output device such as a player piano. Contois has no teaching which would make the limitations of claim 77 obvious. The teaching of Bernard et al does not make up for the deficiencies of Contois in that Bernard et al teaches the

purchase of products from a remote supplier and the delivery of those products to a purchaser. Those products are not analogous to the selected works of claim 77. Merely pointing to Bernard et al does not provide the necessary suggestion, motivation or teaching to make the combination with Contois nor does that combination teach the modifications necessary thereto to make the limitations of claim 77, including the above, obvious. By way of further example, claim 78 adds to claim 67 the following limitation not made obvious by Contois in view of Bernard et al:

"software for controlling a media writing device, coupled to the user's station, whereby selected works can be written to a removable medium after the works are downloaded." (claim 78)

Neither Contois nor Bernard et al address enabling a user to write works to a removable medium as in claim 78. Bernard et al teach delivery of purchased product via a delivery service or to a purchaser in a store.

Further, claim 85 adds the following limitation not made obvious by Contois in view of Bernard et al:

"software to collect information used for billing-related purposes based on presented advertisements, wherein the software is located, at least in part, at one of the user's station or the remote source." (claim 85)

Contois is completely silent relative to advertisements. Bernard et al is directed to facilitating the purpose of goods from a remote source and is also completely silent relative to the subject matter of the limitation added by claim 85 quoted above. Once again, no specific suggestion, motivation or teaching has been identified as to why the combination of Contois in view of Bernard et al, even if properly makeable, would make obvious the limitations of claim 85.

Similar comments apply to the rejections of claims 92-116. For example, claim 92 defines a method which requires:

"creating at least one list of multiple works; downloading at least some of the works on the list from a remote source, via a communications network that is available at least intermittently, to a user station."

Once again, no specific suggestion, motivation, or teaching has been identified whereby the combination of Contois in view of Bernard et al, even if properly makeable, makes obvious the limitations of claim 92. Contois, see Fig. 1 thereof, enables the user to present works from a local source. Bernard et al simply does not address enabling a user to build or create executable play lists of works. Bernard et al is directed to facilitating purchasing of products from a remote source and physical delivery of those products by shipping or directly to a customer in a store. The Examiner has not identified wherein Contois in view of Bernard et al makes obvious "downloading at least some of the works on the list from a remote source, via a communications network" as claimed.

Claim 93 adds to claim 92 the following limitation that made obvious by the Examiner combination:

"wherein at some of the works are presented at the user's station at substantially the same time they are downloaded." (claim 93)

Once again, no specific suggestion, teaching, or motivation has been provided in the rejections which would make the above-quoted limitations of claim 92, in combination, obvious.

By way of further example, claim 108 adds to claim 93 the following unmet limitation:

"presenting at the user's station additional works comprising advertisements at substantially the same time the works on the list are presented at the user's station." (claim 108)

Neither Contois nor Bernard et al address the subject matter of method claim 108. Contois is completely silent relative to advertising. Bernard et al, a product purchasing system,

provides no suggestion, teaching or motivation to modify Contois in accordance with the limitations of claim 108.

For the above reasons, all of claims 92-116 are allowable over Contois in view of Bernard et al. Those rejections should be withdrawn.

In rejecting claims 117-119, the Examiner has stated that:

"These claims are rejected on grounds corresponding to the arguments given above for rejected claims 40-46 and are similarly rejected."

Each of those rejected claims includes one or more limitations which are clearly not made obvious by Contois read in view of Bernard et al. In this regard, claim 117 requires:

"a third plurality of pre-stored instructions for establishing at least intermittently, a communications link between a source of works and the presenting station with at least some of the works provided at the presenting station, via the link, each time they are presented." (claim 117).

The Examiner has failed to identify a specific motivation, teaching or suggestion in connection with the combination of Contois in view of Bernard et al which teach making the required modifications to that combination so as to make the above-noted limitation from claim 117 obvious. Contois discloses and teaches presenting locally available works, see Fig. 1 thereof. Bernard et al teaches the purchase of products from a remote source and physical delivery of same to a purchaser. Nothing about Bernard et al makes up for the deficiencies of Contois in this regard so as to make obvious the above quoted limitation. Similar comments apply to the rejections for claims 118 and 119.

Finally, in responding to the Examiner's comments on page 6 of the Office Action, in section 6, the statement is made:

"examiner maintains that Contois's teaches on col. 5 and col. 11, (i.e. 'control means' and 'interface means'), clearly teaches an editing element to a structure via a user interface and therefore teach applicant's claim of editing features."

The above broad conclusory comment has failed to address the specific limitations of those claims directed to editing capability, such as claim 30 as discussed above. Subsequently, in section 6, the Examiner stated:

"examiner maintain the figs. 2-4 is not limited to permitting a user to add songs, but teaches applicant claim invention of view and selecting works on a selected list (i.e. songs)." [sic]

The above broad generalized comment once again has failed to address the specific wording of the pending claims and the limitations therein as required by the statutory standard.

Subsequently in sections 6, the Examiner stated:

"examiner maintains that Contois's teachings transferring data files clearly has the capacity to contain advertisement and therefore reads on applicant's claim language above." [sic]

The above conclusory statement completely ignores the fact that it is well recognized that even though prior art devices may be capable of being modified to operate as the claimed apparatus, there must be some suggestion or motivation to do so, In re Fritch, 972 F.2d 1260, 23USPQ2d 1780 (Fed. Cir. 1992). The problem with the Examiner's above assertion is a failure to identify the suggestion or modification required so as to make the respective claim limitation obvious. The mere fact that the capacity could be created does not fulfill the statutory standard.

On page 7 of the Office Action, the Examiner has set forth a rationale as to the fact that:


"Both Contois and Bernard are related to the transfer of audio data in an networking environment and therefore one of ordinary skill in the art would have been motivated to combine both references to arrive at applicant's invention."

The above statement completely ignores the substantial differences in the kinds of systems disclosed in Contois and Bernard et al. It is merely conclusory and fails to provide the required specificity as to the reasons the combination makes obvious each of the limitations of the respective claims.

For all of the above reasons, the pending claims are allowable and allowance of the application is respectfully requested.

Respectfully submitted,

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